

REMARKS

By the above amendment, the patented status of the parent application has been updated in the specification and claims 1 - 31 have been canceled without prejudice or disclaimer of the subject matter thereof and new claims 32 - 63 presented. Applicants submit that the newly presented claims patentably distinguish over the cited art and should be considered allowable.

By the present amendment, new claims 32 - 42 are directed to a recording apparatus of a helical scanning system whereas claims 43 - 63 are directed to a reproducing apparatus of a helical scan system. Each of independent claims 32, 36 and 40 directed to the recording apparatus recite the feature of first and second video heads for recording wherein the first video head records a video signal on a magnetic tape when a running speed of a magnetic tape is a standard speed or at a standard track pitch and the second video head records the video signal on the magnetic tape when a running speed of the magnetic tape is approximately 1/5 of the standard speed or approximately 1/3 of the standard track pitch as well as when a running speed of the magnetic tape is approximately 1/3 of the standard speed or approximately 1/3 of the standard track pitch. Independent claims 43, 50 and 57 directed to the reproducing apparatus recite similar features in terms of the reproduction of a video signal in that the first video head reproduces a video signal recorded when a running speed of the magnetic tape is a standard speed or recorded by a standard track pitch and the second video head reproduces the video signal recorded when a running speed of the magnetic tape is approximately 1/5 of the standard speed or approximately 1/5 of the standard track pitch as well as recorded when a running speed of the magnetic tape is approximately 1/3 of the

standard speed or approximately 1/3 of the standard track pitch. The dependent claims recite further features of the present invention.

As to the rejection of claims 1 - 31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of US Patent No. 6,263,151, which is the patent issuing from the parent application of the present continuing application, this rejection is consider to be overcome by the cancellation of claims 1 - 31. Insofar as such rejection may be considered applicable to the newly submitted claims 32 - 63, this rejection is traverse and reconsideration and withdrawal of the rejections are respectfully requested. Applicants note that as indicated by the Examiner, such rejection could be overcome by submission of a terminal disclaimer, but applicants consider that in light of the amendment submitted herewith, a submission of a terminal disclaimer is unnecessary. Applicants further note that only the claimed subject matter of US Patent No. 6,263,151 may be considered in the obviousness-type double patenting rejection and applicants submit that irrespective of the contentions by the Examiner, the claims of US Patent No. 6,263,151 do not appear to disclose a first video head recording a video signal on a magnetic tape when a running speed of a magnetic tape is a standard speed or a standard pitch, and a second video head for recording the video signal of the magnetic tape when a running speed of the magnetic tape is approximately 1/5 of the standard speed or approximately 1/5 of the track pitch and when a running speed of the magnetic tape is approximately 1/3 of the standard speed of approximately 1/3 of the track pitch. Likewise, the claims of US Patent No. 6,263,151 do not appear to disclose a reproduction apparatus wherein the first and second video heads effect reproduction in the manner set forth. Accordingly, applicants submit that claims 32 -

63 patentably distinguish over the claims of the parent patent number 6,263,151 and all claims should be considered allowable thereover.

As to the rejection of claims 1 - 7, 9 - 16, 18 - 21 and 23 - 27 under 35 USC 102(b) as being anticipated by Augenbraun et al (US 5,444,575) and the rejection of claims 5, 8, 17, 22 and 28 - 31 under 35 USC 103(a) as being unpatentable over Augenbraun et al in view of Hamaguchi (US 6,091,561) such rejections are considered to be obviated by the cancellation of claims 1 - 31 and the presentation of new claims 32 - 63. Insofar as such rejections may be considered to be applicable to the newly presented claims, such rejections are traversed and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With regard to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988),

wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Irrespective of the Examiner's contentions concerning Augenbraun, applicants submit that this patent does not disclose a first video head and a second video head operating in the manner set forth in terms of recording and reproduction. More particularly, Augenbraun et al, in the sense of 35 USC 102 and in the sense of 35 USC 103, fails to disclose or teach a second video head which operates for recording or reproducing, in the manner defined, with respect to approximately 1/5 of a standard speed or approximately 1/5 of a track pitch and approximately 1/3 of the standard speed or approximately 1/3 of the track pitch, as recited in the claims of this application. Although the Examiner makes various comments concerning the ability of Augenbraun et al to provide the features of 1/3 and 1/5 speeds or track pitch, applicants submit that the Examiner's position is based on speculation on the part of the Examiner and not the disclosure of the reference, which is not proper under 35 USC 102, (see In re Robertson, supra. Likewise, applicants submit that Augenbraun et al does not teach the recited features concerning the operation of the second video head, as set forth in the claims of this application. As such, applicants submit that all claims patentably distinguish over Augenbraun et al in the sense of 35 USC 102 and 35 USC 103 and should be considered allowable thereover.


As to the combination of Augenbraun et al with Hamaguchi, the Examiner contends that Hamaguchi discloses travel speeds of 1/N where N is an even number. Thus, it is readily apparent that the combination of Hamaguchi and Augenbraun et al fails to provide the claimed features relative to 1/3 and 1/5, as recited in the independent and dependent claims of this application, and all claims patentably distinguish thereover in the sense of 35 USC 103 and should be considered allowable.

In view of the above amendments and remarks, applicants submit that all claims present in this application patentably distinguish over the cited art and should now be in condition for allowance. Accordingly, issuance of an action of a favorable is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 500.36308CX1), and please credit any excess fees to such deposit account.

Respectfully submitted,

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